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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,297	12/19/2000	David L. Hecht	07447.0006	3320

7590

10/27/2003

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EXAMINER
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KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 10/27/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/739,297

Applicant(s)

HECHT ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,7,8,11 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The preliminary amendment filed on June 12, 2002 has been entered and made of record.

### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, claims 1-8 as shown in figure 4

Species B, claims 9-16 as shown in figure 14

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Daniel Curtis (Registration No. 39,159) on October 10, 2003 a provisional election was made without traverse to prosecute the invention of species A, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.

09/737,869. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application covers equivalent subject matter and is merely a broader recitation of claim 1 of the copending application.

### ***Claim Objections***

The following quotation of 37 CFR § 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

7. Claims 1-8 are objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

Referring to claim 1, the phrase “each comprising” in line 2 is unclear. More specifically, it is unclear what “each” is referring to. The Examiner suggests changing the phrase to “each tile comprising”, since it appears that “each” is referring to the periodic tiles.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hecht et al., U.S. Patent No. 6,000,621 ("Hecht") and Mowry, Jr., U.S. Patent No. 5,951,055 ("Mowry").

Referring to claim 1 as best understood, Hecht discloses an embedded data code on a substrate, comprising:

a. periodic tiles, each comprising a predefined code area (51) having a code pattern common to other tiles (col. 6, lines 12-29 and figure 6).

Hecht fails to disclose a predefined occlusion area not necessary for decoding the code pattern. However, this feature was exceedingly well known in the art. For example, Mowry discloses periodic tiles comprising a predefined occlusion area not necessary for decoding a code pattern (col. 9, line 59-col. 10, line 36 and figure 7. Note that the security image "VOID" is interpreted as the predefined occlusion area).

Hecht and Mowry are both concerned with security documents containing periodically tiled glyphs. Mowry provides an improved security document by utilizing two distinct security

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features (Mowry, col. 4, lines 63-64). Therefore, it would have been obvious to include the predefined occlusion area of Mowry in the tile of Hecht, in order to improve the security of the document (substrate).

Referring to claim 2, Hecht further discloses that each tile comprises glyphs (col. 6, lines 12-18).

Referring to claim 3, Mowry further discloses that the occlusion comprises a second code pattern [figure 7. Mowry explains that the occlusion (security image “VOID” 70) is composed of a code pattern (72) that is different from the code pattern (68) of a predefined code area (66), see col. 7, lines 15-37 and figure 3].

Referring to claim 4, Mowry further discloses that the occlusion comprises a graphic (col. 10, lines 27-36 and figure 7. Note that the security image “VOID” is interpreted as a graphic).

Referring to claim 5, Mowry further discloses that the occlusion comprises text (col. 10, lines 27-36 and figure 7).

Referring to claim 6, Mowry discloses multiple occlusions within the periodic tiles (figure 7), but fails to disclose that there are multiple occlusions within a tile. However, the Examiner notes that the number of occlusions within a single tile of Mowry would have depended on the specific location of the tile in the document. For example, it appears that in figure 7, a tile located near the center of the document would include multiple occlusions (“VOID” and “PAY ONLY”). Therefore, it would have been obvious to include multiple occlusions within a tile of Mowry, since the multiple occlusions (enhanced security data) improves the security of the document (col. 10, line 6-36).

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Referring to claim 7, Mowry further discloses that the occlusions are contiguous for occlusion strips spanning across tile boundaries (figure 7. Note that the occlusion strips “NOT VALID OVER FIVE HUNDRED U.S. DOLLARS” spans across tile boundaries).

Referring to claim 8, Mowry further discloses that the occlusion strips contain printing across tile boundaries [figure 7. Note that the occlusion strips “NOT VALID OVER FIVE HUNDRED U.S. DOLLARS” contain printing (text) across tile boundaries].

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Zhang U.S. Patent No. 5,771,245 discloses an embedded data code with periodic tiles containing a code pattern and occlusions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



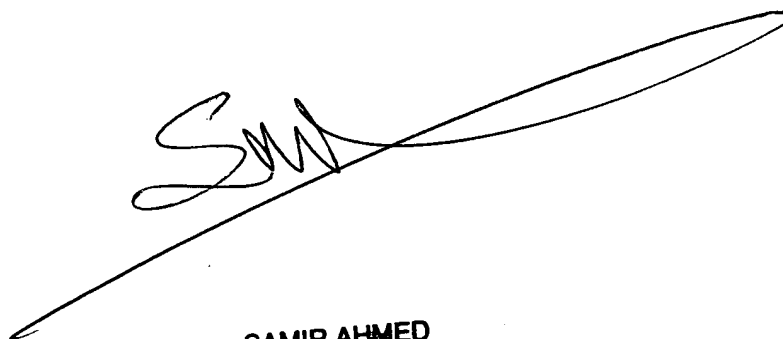
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

al

ck

October 10, 2003

A handwritten signature in black ink, appearing to read 'SAMIR', followed by a long, sweeping horizontal line that extends to the right.

**SAMIR AHMED  
PRIMARY EXAMINER**